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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/236,339	01/25/1999	SEIICHI KASHIWABA	865.4327	1626

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EXAMINER

NGUYEN, THONG Q

ART UNIT PAPER NUMBER

2872

DATE MAILED: 01/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/236,339

Applicant(s)

KASHIWABA ET AL.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2001 and 14 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-11 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-11 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 10/24/2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/236,339 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Amendment

2. The present Office action is made in response to the Pre-Amendment (Paper No. 21) filed on 12/14/2001.

It is noted that in the Pre-Amendment, applicant has canceled claims 4-5 and simultaneously added claims 19-22. As a result, the pending claims 1-2, 6-11 and 19-22 are examined in this Office action.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature concerning the arrangement of the deformation restricting member between the coupling members and the first holding member as recited in each of claims 1, 11, and 19-22 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a) Claim 6 is rejected under 35 USC 112, first paragraph because the specification does not teach the use of an urging member between the coupling member and the deformation restricting member wherein the restricting member is disposed between the first and second holding members.

As described in the present specification, in particular, at pages 23+, the inventive device as understood has the following structure: 1) a first holding member (109) for supporting a first optical element (L3) wherein the first holding member comprises a plurality of legs (109a) extending in the direction of the optical axis of the lens system, which each leg comprises an abutting surface (109b); 2) a second holding member (118) for supporting a second optical element (L6) wherein the second holding member comprises a plurality of flanges (118a) which each flange extends in a direction perpendicular to the optical axis of the lens system; 3) a plurality of coupling members (145); 4) a plurality of urging members (120); and a deformation restricting member (119) having a substantially annular shape. In the first embodiment, the deformation restricting member (119) is positioned between the urging member (120) and the

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second holding member (118). At pages 25+, the specification teaches that the deformation restricting member (119) can locate between the first holding member (109) and the second holding member (118). At pages 27+, the specification also implies that the system can have two deformation restricting members wherein one is located between the urging member (120) and the second holding member (118) and the other is located between the first (109) and second (118) holding members. However, the specification has never taught that the urging member (120) is located between the coupling member (145) and the restricting member (119) wherein the restricting member (119) is located between the first holding member (109) and the second holding member (118) as recited in claim 6/1. See claim 1, lines 9-16 and claim 6, lines 2-3.

6. Claims 19-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a) Claim 19 is rejected under 35 USC 112, first paragraph because the disclosure, as originally filed, does not provide support for the feature thereof "said second holding member...coupling members" recited on last four lines of the claim. Applicant should note that the disclosure, as originally filed, disclose a holding member (118) having a plurality of flanges (118a) wherein each flange comprises only one hole (118b) for receiving the thread/shaft of the coupling

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member (145). See pages 24-25 and fig. 4. The disclosure, as originally filed, does not teach that each flange (118a) has more than one hole as claimed.

b) Each of claims 20-22 is rejected for the same reason as set forth in element a) above.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 19 is rejected under 35 USC 112, second paragraph for the following reason. The feature thereof "said deformation...coupling members" (lines 20-21) is unclear due to the claim language being inaccurate. In other words, it is unclear how a plurality of holes can receive only one coupling member as recited. Applicant should note that the specification discloses a deformation restricting member (119) having a plurality of set of holes (119a-119c) wherein each set of holes (119a-11c) comprises a hole (119a) for receiving the thread of the coupling member (145). See figure 4, for example. As such, should "one of" (line 21) be deleted?

b) Each of claims 20-22 is rejected for the same reason as set forth in element a) above.

Double Patenting

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

10. Claim 9/7/1 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 7/1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Note: The feature concerning the use of a restricting member as recited in claim 9 is clearly recited in claim 1.

11. Claim 21 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 19. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

It is noted that the differences between claim 21 and 19 is the positive recitation of the optical axes of the first and second optical elements and the coupling of the first and second holding members at a position within a range of relative

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movement between two holding members (see claim 21, lines 2-8); however, such features are readable from the feature "a first holding...being coupled" (claim 19, lines 2-13), in particular, in the language thereof "permit relative positions of said ...being coupled" (claim 19, lines 5-7) and "said plurality...optical element" (claim 19, lines 10-13).

12. Claim 22 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 20. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

See the same reason as set forth in element 11) above.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-3, 6-9, 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Sezerman (U.S. Patent No. 4,889,406) in view of Kohno (U.S. Patent No. 5,652,922, of record).

Sezerman discloses an optical system having a first fiber (12), a second fiber (14) and a coupling apparatus for coupling the two mentioned fibers. The coupling system comprises a first base plate (18) supporting the first fiber (14), a

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second base (16) supporting a second fiber; a plurality of coupling elements (34, 34a), and an deformable annular ring (32). The system when completely being assembled has the deformable annular ring located between the two base plates, and each of the coupling member will go through the holes formed on each of the plates and the ring. Each of the base plates comprises a bore for supporting the fiber so that the optical axes of the fibers will be kept in alignment to each other. The operation on the coupling members will permit a relative movement of the base plates with respect to each other. The only feature missing from the optical system provided by Sezerman is that he does not disclose the use of urging members between the coupling members and the second base plate as claimed. However, the use of urging members in the form of a deformable washers with the coupling members in the form of screws for coupling two elements is clearly suggested to one skilled in the art as can be seen in the optical system provided by Kohno. For instance, at column 7 and in figure 10A, the coupling system comprises a plurality of screws (25) and deformable washers (22) wherein the coupling system is used to couple the first element (7) to the second element (21). It is noted that the use of a press plate between the screws and the first holding member is also suggested by Kohno when he teach the use of the press plate (24) between the screws (25) and the holding member (7). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the optical system provided by Sezerman by using urging members in the form of deformable washers as suggested by Kohno for the purpose of

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preventing the damage to the holding member during the time of coupling the holding members together.

15. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sezerman in view of Kohn as applied to claim 7 above, and further in view of Hasegawa (U.S. Patent No. 4,780,640).

The combined product as provided by Sezerman and Kohno as described in the paragraph 14) above meets all of the limitations recited in claim 10 except the position of the urging member with respect to the coupling member and the press plate. While Kohno discloses the washer (22) is located between the press plate (24) and the holding member (7), he does not state that the washer can locate between the coupling member (25) and the press plate (24). However, a rearrangement of the components while still providing the same function involves only routine skill in the art as can be seen in the Courts decision, **In re Japikse**, 86 USPQ 70. It is also noted that such an arrangement of a coupling system having a screw, a washer, a press plate wherein the coupling system is used to couple two systems together is disclosed in the art as can be seen in the system provided by Hasegawa. See columns 3-4 and fig. 3, elements 6, 10, 9 and 5. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product as provided by Sezerman and Kohno by rearranging the positions of the urging member, the press plate and the coupling member as suggested by Hasegawa so that the urging member

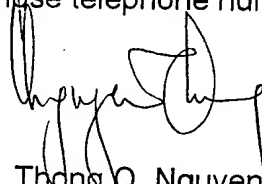
is located between the coupling member and the press plate for the purpose of preventing the damage of excess force to the press plate.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is 703 308 4814. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on 703 308 1687. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 7724 for regular communications and 703 308 7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
Art Unit 2872

January 8, 2002